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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>September 6, 2007</u></p> <p>Signature _____</p> <p>Typed or printed name <u>Peter K. Trzyna</u></p>		Application Number	Filed
		09/295,230	19 April 1999
		First Named Inventor	
		EWING, Christopher	
		Art Unit	Examiner
		3638	DIXON, Thomas A.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 32601 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>4</u> forms are submitted.</p>			



Signature
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Telephone number
September 6, 2007

Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Status of Claims

Amendments filed on May 8, 2007, and May 7, 2007, have been entered by the Examiner.

Claims 129-133 are allowed.

Claims 3, 10, 22-27, 35, 42, 51-61, 67, 74, 83-93, 99, 106, 118-123, and 126 are objected to as being allowable if rewritten in independent form, but currently depending from a rejected independent claim.

Claims 1, 2, 4-9, 11-21, 28-34, 36-41, 43-50, 62-66, 68-73, 75-82, 94-98, 100-105, 107-117, 124-125, and 127-128 stand rejected.

1. Clear Errors or Omissions: The Examiner has not fully considered the Declaration of Professor Lee A. Hollaar, in compliance with Rule 132.

The Examiner has not fully considered the Declaration of Professor Lee A. Hollaar, in compliance with Rule 132. Specifically the entire declaration has been dismissed because some sections speak to limitations that were viewed as contentious, however, the Examiner failed to provide consideration to paragraph 12, which is directed to at least one fundamental misinterpretation of the claims, as proffered by the Examiner. Moreover, the Examiner stated that "further the examiner is unsure what section 132 is a section of."

Therefore the finality of the rejection was premature.

2. Clear Errors or Omissions: the Examiner did not comply with Rule 104, particularly 104(a)(2) and 104(c)2.

The amendments after final changed the scope of the claims (see amendments to claim 1, for example). However, the Examiner did not comply with Rule 104, particularly 104(a)(2), which requires, at least in part, as reproduced in part below:

...The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant,..., to judge the propriety of continuing the prosecution

and 104(c)(2) which requires, at least in part, as reproduced in part below:

...When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The Examiner merely states the following in the Advisory Action of, June 18, 2007:

The amendment of the claims clarifies claim 1 and claim 9, 41, 73, 105 and would be rejected using the same Bezos rejection,...

The Examiner's statement fails to provide information that would aid the Applicant in judging the propriety of the rejection. Further, Applicant believes that this statement does not clearly provide a rational nor does it provide the particular part(s) relied on which resulted in this adverse action. In short, the Examiner has swept away the Applicant's rights under the Rules by stating that the amendment "would be rejected using the same Bezos rejection". This is without any statement as how Bezos might be asserted; just that it would be. Therefore, upon entering the amendment, if the art was to be correctly applied in a rejection under the Rules, the Examiner should have reopened prosecution to provide the Applicant a reasonable basis for rejecting the new limitations.

3. Clear Errors or Omissions: No cited art teaches or suggests a claim element.

Claim 1 can not be anticipated, under 102(e), by Bezo, since the reference fails to disclose:

determining, over the Internet, whether said second party would accept the gift...

if said second party would not accept the gift, electronically informing said first party that said second party has chosen not to accept said gift; and

if the second party would accept the gift, processing said request to send said gift to produce computer output enabling said gift to be sent to said second party, and wherein the method is carried out without revealing a non-pseudonymous name of one of said parties to another of the parties, according to the request"

Specifically, the Examiner's position, as stated in the Final Office Action dated March, 07, 2007, is based on his opinion that a package that is non-deliverable would meet the affirmative action of making a determination as to whether a person would accept a gift, as recited in the claims. The positive recitation and deliberate act by the second person of "accepting" or not accepting a package is clearly different than the passive act of not being home to receive the gift or a telephone call to have the gift delivered. Further, the act of not being home does not constitute an affirmative action that would be "informing said first party that said second party has chosen not to accept said gift" as recited in the claim. The act, as claimed, of acceptance or not accepting is not the same as handling whether a package is not deliverable to a recipient, as the Examiner has argued.

Accordingly, claim 1 cannot be anticipated by Bezos, and the rejections of dependent claims based on the faulty rejection of claim 1 are therefore deficient too.

4. Clear Errors or Omissions: No cited art teaches or suggests a claim element.

Claim 19 also cannot be anticipated, under 35 USC 102(e), by Bezos. After a comprehensive reading of Bezos with a keen eye on the Examiner's citations from the Final Rejection dated, March, 7, 2007, specific to paragraph 0016, lines 1-14 and paragraph 0022, Bezos does not and cannot teach the claimed "without revealing a non-pseudonymous name corresponding to said first party to said second party and without revealing a non-pseudonymous name of said second party to said first party". The rejection is therefore deficient. Lastly, it is clear from Bezos that whatever the Examiner might be seeking to argue is in fact human activity and through telephonic means and is not implemented in a "gift giving Web site" as recited in claim 19.

Accordingly, claim 19 cannot be anticipated by Bezos, and the rejections of dependent claims based on the faulty rejection of claim 19 are therefore deficient too.

5. Summary

The Applicant respectfully believes clear errors and omissions have been set out above, that the outstanding rejections have been overcome, and that all claims are therefore in condition for allowance.